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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,620	05/08/2007	Jakob Maier Jun	4100.P0423US	9965
23474 7590 01/14/2009 FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631				
EXAMINER HAYES, KRISTEN C				
ART UNIT 3643		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,620

Applicant(s)

MAIER JUN ET AL.

Examiner

Kristen C. Hayes

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- Paper No(s)/Mail Date 20061016, 20060726
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Election/Restrictions

2. Applicant's election with traverse of Group II, claims 40-50 in the reply filed on 10/27/2008 is acknowledged. The traversal is on the ground(s) that Groups I and II contain a common inventive concept. This is not found persuasive because the conically tapering shape of the insertion opening seems to prevent the inner annular fold from contacting the teat rubber (claim 40), the conically tapering insertion opening enhancing pressure and attachment of the teat rubber to the teat is not mentioned by the disclosure. Furthermore, there is no special technical feature and therefor no unity of invention, as evidenced below in the rejection of claim 40.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/27/2008.

Drawings

3. Figure 1 should be designated by a legend such as –Prior Art– because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the conically tapering surface being concave or convex (claim 40); the conical tapering surface along with the hingelike transition being a portion of reduced material thickness or an indentation (claim 42); and the conical embodiment of the conically tapering surface along with the teat bearing section or suction connecting piece being cushioned (claims 43-50) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 26, 11, 23, 18, 111, 323, 326, 318, 311, 436, 437, 450, 426, 521, 511 and 611. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8. Claim 40 recites the limitation of the conically tapering insertion opening preventing the inner annular fold from contacting the teat rubber

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 40-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 40 recites the limitation "the inner side" in line 19, "the inner annular fold" in line 21, "the base of the teat" in line 22, "the udder" in line 25, "the planar teat bearing section" in line 32 and "the udder bearing surface" in line 32. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 41 recites the limitation "the boundary" in line 2, "the udder bearing surface" in line 4, "the udder" in line 6, "the inner annular fold" in line 6, "the udder" in line 8, "the milking process" in line 9, "said inner annular fold" in line 9 and "the narrow, pressure-exerting area" in line 10. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 42 recites the limitation ""the planar teat bearing section" in line 4 and "the udder bearing surface" in line 5. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 43 recites the limitation "the planar teat bearing section" in line 3 and "the inner surfaces of the suction connecting piece" in line 5. There is insufficient antecedent basis for this limitation in the claim.

15. Claims 44 and 49 recite the limitation "the cushioned surface". There is insufficient antecedent basis for this limitation in the claim. These limitations should be changed from "the cushioned surface consists" to ~~–the cushioned surfaces consists–~~ in claim 44 and from "the cushioned surface is" to ~~–the cushioned surfaces is are–~~ to maintain the continuity of the claims.

16. Claim 46 recites the limitation "the surface of the component in question" in line 3. There is insufficient antecedent basis for this limitation in the claim. Also, the wording of "the component in question" is broad and could include any component of the device, which makes the limitation indefinite.

17. Claim 47 recites the limitation "the whole planar teat bearing section" in line 3. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 50 recites the limitation "the cushioned pocket" in line 3. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 40 contains the limitation "(Fuerstenberg' sche Venenring)". It is unclear as to what the limitation is and whether this it is intended to be included in the claim.

20. Claim 41 contains the limitation of "a wide opening". The wording of the claims suggests the wide opening is an additional opening.

21. Claim 42 includes the limitation of the hingelike transition "comprises a portion of reduced material thickness, an indentation or a variation of the material properties". It is unclear as to if these limitations are claimed as alternatives.

22. Claims 43 and 47 contain the limitation "and/or". It is unclear as to whether the limitation is optional, which renders the claim indefinite.

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

24. Claims 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al US 4,610,220.

25. Regarding claim 40, Goldberg discloses a teat rubber (Goldberg, Figures 4, 5) comprising a head part (14', 114) having a sealing lip (30', 156) that forms an insertion opening, a holding edge (122) (Goldberg, Figure 4), a milking cup sleeve (15), a suction connecting piece (near 34', near 168) connected to the head part as well as a planar teat bearing section (50, 144) which is formed on the sealing lip, a part of the insertion opening conically tapering (near 30', near 156)(Goldberg, Figures 4, 5)towards the inner side of the teat rubber in such a way that the inner annular fold (as best understood) located on the base of the teat cannot come into contact with the teat rubber and that pressure cannot be applied thereto, not even if the milking cup should shift in the direction of the udder (as best understood), characterized in that a conically tapering surface (near 30', near 156) cross section is concave and that a transition between the conically tapering surface and the planar teat bearing section and the udder bearing surface (at 52, at 142, 146) is implemented in a hingelike manner (Goldberg, column 4: lines 33-35, column 6: lines 29-32) (indentations at 30', 52, 156, 154).

26. Regarding claim 41, Goldberg further discloses a wide opening of the conically tapering insertion opening being followed by an udder bearing surface (at 52, at 142, 146) by means of which the teat and parts of the udder with the inner annular fold can be prevented from being

drawn into the teat rubber by a milking vacuum, when the udder shrinks during the milking process.

27. Regarding claim 42, Goldberg further discloses the hingelike transition comprising a portion of reduced material thickness (Goldberg, column 4: lines 33-35, column 6: lines 29-32) and an indentation (30', 52, 156, 154).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al US 4,610,220 in view of Silver et al US 2002/0198489.

30. Regarding claim 43, 47, Goldberg discloses the device of claim 42 and further discloses a cushion portion (52, 142, 146) on the teat rubber. Not disclosed is a cushion portion on the whole planar teat bearing section. Silver teaches a teat receiving portion having cushioned surfaces planar teat bearing sections (735, 740) (Silver, ¶0160). It would have been obvious to one of ordinary skill in the art at the time of the invention to cushion the planer teat bearing section of Goldberg as to increase the comfort of the device for the animal.

31. Regarding claims 44 and 45, Goldberg in view of Silver discloses the device of claim 43 and further discloses the cushioned surface consisting of foam (Silver, ¶0160). Not disclosed is the foam being a foamed silicone elastomer. However, foamed silicone elastomer is well known in the art. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the foam a foamed silicone elastomer as to maintain the flexibility of the teat rubber while providing cushion.

32. Regarding claim 46, Goldberg in view of Silver discloses a foamed elastomer. The limitation of the foamed elastomer being sprayed onto a surface is considered a product-by-process limitation. It has been held that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966.

33. Regarding claim 48, Goldberg in view of Silver further discloses the cushioned surfaces being cushioned pockets (Silver, 742, 738, 740).

34. Regarding claim 49, Goldberg in view of Silver further discloses the cushioned surface being a fluid-filled pad (Silver, 740).

35. Regarding claim 50, Goldberg in view of Silver further discloses the fluid-filled pad being a replaceable insert (Silver, 340) (in that the fluid-filled pad is a separate element. The area in which the pad is positioned is openable, as the wall elements rest on each other and are therefore not permanently connected (Silver, ¶0159: lines 7-9)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Hayes whose telephone number is 571-270-3093. The examiner can normally be reached on Monday-Thursday, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571)272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCH
8 January 2009

Peter Poon
Examiner
Art Unit 3643

/Peter M. Poon/
Supervisory Patent Examiner, Art Unit 3643